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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/908,697 | 07/20/2001 | Kazutaka Matsueda | 35.G1362 D | 1944 |

5514 7590 07/31/2002

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EXAMINER

GARCIA, GABRIEL I

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 07/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|--|------------------------------|------------------|
| | Application No. | Applicant(s) |
| | 09/908,697 | Matsuenda et al |
| | Examiner <i>H. Marcia</i> | Art Unit 2624 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 7/20/01.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. 08/352,883.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 1

6) Other:

Part III DETAILED ACTION

1. This application is a division of application number 08/352,883. Applicant's amendment filed on 7/20/01 has been entered. Claim 1 is pending in the application. Applicant should update the cross reference made to the U.S. application recited on page 1 of the specification to indicate the patent number.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Double Patenting

3. The claim 1 is rejected under the judicially created doctrine of the obviousness type double patenting of the claim(s) in applicant's prior United States Patent No. 6,301,016. Although the designs are not identical, they are not patentably distinct from each other because both the pending claim of this application and the claim(s) of United States Patent No. 6,301,016 contain: means for inputting data, means for outputting, means for detecting, means for transferring, and means for storing. Claim 1 of the present application reads on the claim(s) of United States Patent No. 6,301,016. The

obviousness type double patenting rejection is a judicially established doctrine based on public policy, and is primarily intended to prevent prolongation of monopoly by prohibiting a claim in a second patent not patentably distinguishable from a claim in a first patent.

A timely filed terminal disclaimer will obviate this rejection. (MPEP § 1490) *In re Vogel*, 164 USPQ 619 (CCPA 1970).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hisano (5,027,386).

With regard to claim 1, Hisano teaches a data processing apparatus (fig. 1) connectable to a LAN (see fig. 1), comprising: input means (8) for inputting data; communication means (9) for transmitting and receiving data output means (2 or 3) for outputting the data that has been input via said input means (8)

or received via said communication means (9); detection means (1) for detecting an error state in said output means (reads on col. 4, lines 36-68); transfer means (6) for transferring the data to another apparatus connected to the LAN thereby outputting the data via the other apparatus in a case where said detection means has detected an error state in said output means (e.g. col. 4, lines 36-68); and storage means (10) for storing information identifying the other apparatus to which the data has been transferred via said transfer means (e.g. figs. 2 and 3A, and col. 4).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (e) the invention was described in-
 - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
 - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Ueno (5,978,097).

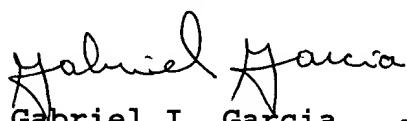
With regard to claim 1, Ueno teaches a data processing apparatus (fig. 1) connectable to a LAN (reads on fig. 1, item labeled NCU, which is the network connection to other output devices), comprising: input means (10) for inputting data; communication means (18) for transmitting and receiving data output means (30) for outputting the data that has been input via said input means or received via said communication means () see fig. 1; detection means for detecting an error state in said output means (reads on fig. 2); transfer means for transferring the data to another apparatus connected to the LAN thereby outputting the data via the other apparatus in a case where said detection means has detected an error state in said output means (e.g. fig. 2 and abstract); and storage means (36) for storing information identifying the other apparatus to which the data has been transferred via said transfer means (e.g. fig. 2).

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sugiyama et al. (5,859,956) teaches image processing apparatus for transferring data to other apparatuses connected to a LAN.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Gabriel I. Garcia** whose telephone number is (703) 305-8751. The examiner can normally be reached Monday-Thursday from 7:30 AM-6:00 PM. The fax phone number for this group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 306-0377.


Gabriel I. Garcia GABRIEL GARCIA
Primary Examiner PRIMARY EXAMINER
July 25, 2002